



PATENT  
81087-250435

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

# 3

In re application of: ) Art Unit: 2185  
 ) Examiner: Unknown  
 SOHEILA ABDOLBAGHIAN ET AL. )  
 )  
 Serial No.: 09/721,498 )  
 )  
 Filed: November 22, 2000 )  
 )  
 For: SYSTEM AND METHOD FOR )  
 COMPUTER APPLICATION )  
 MANAGEMENT )

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JUL 25 2001

OFFICE OF PETITIONS

**PETITION UNDER 37 CFR 1.47(a) TO FILE WHEN INVENTORS REFUSE TO JOIN**

Office of Petitions  
Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

Dear Sir:

**BACKGROUND**

1. Assignee TOSHIBA AMERICA INFORMATION SYSTEMS, INC. (TAIS) respectfully requests that the enclosed Declaration for the above application be accepted under this Petition. The Declaration of Proof of Tuan Nguyen's Refusal to Execute Application ("Declaration") is enclosed in support of this Petition under 37 CFR 1.47(a). Evidence of the following facts is set forth in the Declaration. A Declaration and Power of Attorney executed by joint inventor SOHEILA ABDOLBAGHIAN is also enclosed in support thereof.

2. By virtue of his employment agreement with TAIS, TUAN NGUYEN, a joint inventor of the instant application, agreed to assign their entire right, title and interest in

the instant application to TAIS on February 18, 1997. Mr. Nguyen was employed by TAIS at all times between the date of conception of the invention and June 2, 2000, the date on which his employment by TAIS was terminated. The employment agreement is included as Exhibit 1 to the Declaration.

3. On May 30, 2001, Mr. David J. Harshman, an attorney employed by TAIS and acting on behalf of TAIS, sent a letter (Exhibit 2 to the Declaration) to Mr. Nguyen requesting that he execute the instant application. The specification for the application, a "Declaration and Power of Attorney" form, and an "Assignment" form were appended to the letter. The letters requested that Mr. Nguyen return the signed Declaration in a provided self-addressed, stamped envelope. The letter were sent by certified mail to the addresses listed below in paragraph 6.

4. Mr. Harshman received Postal Forms 3811, signed by Mr. Nguyen on June 14, 2001, indicating that he received the letters and documents mentioned in paragraph 4 at the address listed in paragraph 6. A copy of the form is attached as Exhibit 3 to the Declaration.

5. TAIS has received no response from Mr. Nguyen regarding its request that he join in prosecution of the instant patent application.

6. The last known address of Mr. Nguyen is as follows:

26575 White Oaks Drive  
Laguna Hills, CA 92653

The Declaration was signed by Mr. Harshman on July 13, 2001. Due to the Mr. Nguyen's refusal to execute the Declaration of Inventorship for the instant application,

this action is necessary to preserve the proprietary rights of TAIS, the assignee of the Inventors' entire right, title and interest in the patent application. A check in the amount of \$130.00 is enclosed in payment of the Rule 1.17(h) fee for the filing of this Petition and a second check in the amount of \$390.00 is enclosed in payment of the fee for a two-month extension of time for compliance with the Notice of Missing Parts dated March 23, 2001.

Accordingly, it is respectfully requested that the instant application be accepted under 37 CFR 1.47(a). If for any reason the Examiner finds the Petition deficient, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

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Respectfully submitted,

JUL 25 2001

PILLSBURY WINTHROP LLP

OFFICE OF PETITIONS

Dated: July 19, 2001

By:

  
Charanjiit Brahma  
Registration No. 46,574  
Attorney for Applicant(s)

725 South Figueroa Street, Suite 2800  
Los Angeles, CA 90017-5406  
Telephone: (213) 488-7100  
Facsimile: (213) 629-1033

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Washington D.C. 20231, on

July 19, 2001  
Date of Deposit

Charanjiit Brahma, Reg. No. 46,574

  
Signature

July 19, 2001  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: ) Art Unit: 2185  
SOHEILA ABDOLBAGHIAN ET AL. ) Examiner:  
Serial No.: 09/721,498 )  
Filed: November 22, 2000 )  
For: SYSTEM & METHOD FOR )  
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MANAGEMENT )

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**OFFICE OF PETITIONS**

**DECLARATION OF PROOF OF TUAN NGUYEN'S REFUSAL  
TO EXECUTE APPLICATION**

I, David J. Harshman, declare as follows:

1. I am an attorney employed by TOSHIBA AMERICA INFORMATION SYSTEMS, INC. ("TAIS") and I am authorized to act on behalf of TAIS. Furthermore, I was an attorney employed by TAIS on May 30, 2001 and was authorized to act on behalf of TAIS on May 30, 2000.

2. One of the joint inventors listed in the above-mentioned patent application, TUAN NGUYEN, was employed by TAIS at all times between the date of conception of the invention and June 2, 2000, the date on which Mr. Nguyen's employment agreement with TAIS was terminated. As part of his employment agreement with TAIS, Mr. Nguyen agreed to assign their entire right, title and interest in the instant application to TAIS. A copy of the employment agreement, executed by Mr. Nguyen on February 18, 1997, is included as Exhibit 1.

3. On May 30, 2001, I sent the attached letter (Exhibit 2) to Mr. Nguyen requesting that he execute the instant application. The specification for the application, a "Declaration and

Power of Attorney" form, and an "Assignment" form were appended to the letter. The letter requested that Mr. Nguyen return the signed Declaration in a provided self-addressed, stamped envelope. The letter was sent by certified mail to the address listed below in paragraph 6.

4. I received a Postal Form 3811, signed by Mr. Nguyen on June 14, 2001, indicating that Mr. Nguyen received the letter and documents mentioned in paragraph 3 at the address listed in paragraph 6. A copy of the signed Postal Form 3811 is attached as Exhibit 3.

5. No response has been received from Mr. Nguyen regarding our request to join in prosecution of the instant patent application.

6. The last known address of Mr. Nguyen is as follows:

26575 White Oaks Drive  
Laguna Hills, CA 92653

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: July 13, 2001



Name: David J. Harshman

Title: Assistant General Counsel

for Toshiba America Information Systems, Inc.

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## EMPLOYEE AGREEMENT AND ACKNOWLEDGEMENT OF OBLIGATION

In consideration of my employment and the compensation paid to me by TAIS, I agree as follows:

### I. DEFINITIONS

As used herein, 'TAIS' shall mean Toshiba America Information Systems, Inc., 'Customer' shall mean any person or entity to whom TAIS sells services, equipment, materials or designs or from whom TAIS obtains information or from whom I obtain information as a result of my employment by TAIS; 'Supplier' shall mean any person or entity from whom TAIS obtains services, equipment, material designs or products; 'Information' shall mean any information or knowledge, written or oral, or data relating to proposals, plans, specifications, documents, inventions, computer programs, technology, know-how, methods, processes, products, customer lists or operations of TAIS, Supplier or Customer, and 'Employment' shall include employment for hourly wages, for salary, or as a consultant.

### II. SECRECY AGREEMENTS

I recognize that the business of TAIS and the nature of my Employment will permit me to have access to Information and that such Information is the property of TAIS or of its Supplier or Customer. I will regard and preserve as confidential all Information obtained by me in connection with my Employment. I will not, without written authority from TAIS to do so, use for my own benefit or purposes nor disclose to others, either during my Employment or thereafter, except as required in the line of my Employment with TAIS, any Information and I will not remove without authorization, retain, or transmit by any means, copy or disclose any of TAIS's or of its Suppliers or Customer's specifications, drawings, blueprints, reproductions, computer programs, or other documents of Information, or things, except as required in the line of my Employment with TAIS.

### III. INVENTIONS

- A. I agree that all inventions, discoveries, and improvements for which equipment, supplies, facility, or trade secret information of TAIS or its Supplier or Customer was used and which was developed by me, either alone or with others during or outside regular hours, and (1) which relates (a) to the business of TAIS or its Supplier or Customer or (b) to TAIS actual or demonstrably anticipated research or development, or (2) which results from any work performed by me for TAIS hereinafter collectively referred to as "Inventions", are and shall be the sole property of TAIS. In the event California law is deemed to govern my rights and obligations under this paragraph, this paragraph IIIA shall not apply to any inventions that qualify fully under the provisions of Section 2870 of the California Labor Code, as amended.
- B. I will disclose promptly and in writing to the individuals designated by TAIS all of said Inventions and I hereby assign and agree to assign to TAIS all my rights, title and interest therein and not to disclose any of these to others without the express consent from TAIS. Further, I will at any time during or after my Employment, on request from TAIS, execute specific assignments in favor of TAIS or its nominee, of all of said Inventions as well as execute all documents, papers, and perform all lawful acts that TAIS considers necessary or advisable for the preparation, application, prosecution, issuance, procurement and maintenance of patents, of the United States and foreign countries for said Inventions, and for the transfer of any interest I may have herein, and will execute any and all papers and lawful documents required or necessary to vest title thereto in TAIS or its nominee, and I will execute all documents and assist at TAIS's expense in the preservation of all TAIS's interest arising from this Agreement.

### VI. CONFLICTS INTEREST

I recognize that I owe a primary and fiduciary duty to my employer, TAIS and that I shall not have any interest, financial or otherwise, direct or indirect, or engage in any business or transaction of any nature, which is in conflict with the proper and faithful discharge of my duties as a TAIS employee. Without limiting the generality of the foregoing, I agree that I will not, while employed by TAIS, directly or indirectly:

- (a) Be employed by or receive any compensation from, a Customer, Supplier or Competitor of TAIS; or
- (b) Have any ownership or financial interest of any nature, in a Customer, Supplier or Competitor of TAIS, except where such ownership is stock in a corporation and consists of less than one percent of the outstanding capital stock of such Customer, Supplier or Competitor and where such stock is publicly held and listed on a recognized Stock exchange or actively traded in the over-the-counter market; or
- (c) Have or participate in any dealings on behalf of TAIS, with a Customer or Supplier that employs, or more than five percent of whose ownership interest is beneficially held by, my spouse or any brother, sister, parent, child or grandchild of me or my spouse, or any person living in my household or the spouse of any of the foregoing persons; or
- (d) Solicit, accept or receive any gift having a value of fifty dollars or more, whether in the form of money, service, loan, hospitality (except for ordinary business meals), thing or promise, or in any other form,

under circumstances which it could reasonably be inferred that the gift was intended to influence me in the performance of my duties on behalf of TAIS, or was intended as a reward for any action on my part on behalf of TAIS, unless such fact or activity is first fully disclosed in writing by me to the President of TAIS and such President approves in writing of such fact or activity.

#### V. COMPLIANCE WITH LAW

I also agree that I have an obligation to my employer, TAIS, to perform my duties on TAIS's behalf in a lawful manner. While in TAIS's employ and acting or purporting to act on TAIS's behalf, I agree that I will comply with all applicable federal, state or local laws and regulations.

#### IV. CONCLUSION

The Agreement and Acknowledgement of Obligations shall be effective as of this day of FEBRUARY  
18, 1997.

By Tuan Nguyen  
Employee Signature

### SOFTWARE POLICY AGREEMENT

#### POLICY:

It is the policy at TAIS that software licensed by Toshiba shall not be copied for use on more than one PC, and will be used in strict compliance with the manufacturer's licensing agreement. Reproducing computer software without authorization violates the US Copyright law, and will not be tolerated at Toshiba.

#### SCOPE:

This policy applies to all TAIS corporate and division personnel at the corporate facility, and all employees in field locations.

#### DEFINITIONS:

##### Software Piracy:

Making and using illegal software copies as specified by the particular licensing agreement.

I understand:

- 1) TAIS licenses the use of its computer software from a variety of outside companies, and that TAIS nor any of employees has the right to reproduce it.
- 2) When using software on a local area network, TAIS employees will use the software only in accordance with the license agreement.
- 3) TAIS employees learning of any misuse of software or related documentation within the company shall notify their department manager or the MIS PC Support Department.
- 4) Any TAIS employee caught making, acquiring or using unauthorized copies of software licensed by TAIS will be subject to discipline deemed appropriate up to and including dismissal.
- 5) According to US Copyright Law, illegal reproduction of software can be subject to civil damages of \$50,000 or more, and criminal penalties including fines and imprisonment.

My signature below indicates that I have read and understand the software protection policies of TAIS, and agree to comply with those policies.

Name	<u>TUAN A NGUYEN</u>	Division	<u>CSE</u>
Signature	<u>Tuan Nguyen</u>	Date	<u>2-18-97</u>
Witnessed	<u>W.Hell</u>	Date	<u>7/18/92</u>

**TOSHIBA AMERICA INFORMATION SYSTEMS, INC.**

**HANDBOOK ACKNOWLEDGMENT**

My signature below indicates that I have received a copy of TOSHIBA AMERICA INFORMATION SYSTEMS, INC. Employee Handbook. I understand that the Handbook contains information regarding the Company's rules, regulations and benefits which affect me as an employee. I will read and retain it for future reference.

**I ALSO UNDERSTAND THAT THE COMPANY MAY SUBSTANTIALLY REVISE, SUPPLEMENT OR RESCIND ANY OF THE POLICIES, PROCEDURES OR BENEFITS DESCRIBED IN THE HANDBOOK, WITH OR WITHOUT NOTICE. THE HANDBOOK IS NOT INTENDED TO NOR DOES IT CONSTITUTE A CONTRACT OF EMPLOYMENT. BY SIGNING THE EMPLOYMENT APPLICATION, I AGREE TO AN "AT WILL" EMPLOYMENT RELATIONSHIP WHICH CAN BE TERMINATED AT ANY TIME, WITH OR WITHOUT NOTICE, FOR ANY REASON NOT PROHIBITED BY STATUTE.**

I further understand I am expected to read this Handbook and become familiar with its contents.

TUAN NGUYEN

Name (Please Print)

Tuan Nguyen

Signature

2-18-97

Date

**This page must be signed and sent to the Human Resources Department within five (5) working days.**

# TOSHIBA

TOSHIBA AMERICA INFORMATION SYSTEMS, INC.

**LEGAL DEPARTMENT**

9740 IRVINE BLVD., P.O. BOX 19724, IRVINE, CALIFORNIA 92618-1697  
TELEPHONE: (949) 583-3517, FAX: (949) 587-6235

Donald S. Gray

*Vice President, General Counsel & Secretary*

David J. Harshman

*Assistant General Counsel*

Julie I. Pierce

*Senior Attorney*

Polene Liu

*Senior Attorney*

Ira M. Wafel

*Senior Attorney*

Michael B. Ayers

*Attorney*

VIA CERTIFIED, RETURN RECEIPT U.S. MAIL

May 30, 2001

Tuan Nguyen  
26575 White Oaks Drive  
Laguna Hills, California 92653

Re: U.S. Patent Application Serial No. 09/721,498 for:  
SYSTEM AND METHOD FOR COMPUTER APPLICATION MANAGEMENT  
IS-CSD-138

Dear Tuan:

Enclosed are invention patent documents that require your review and signature. As the inventor, please review the patent application to make sure that it fully describes your invention such that a person of ordinary skill in the art would be informed how to make and use it. Also, please check to make sure that your preferred form of the invention (the "best mode"), as known at the time the application was filed, is disclosed.

By signing the declaration, you are attesting under penalty of perjury that you, and you alone, originally invented the invention as claimed. By signing the declaration, you are also attesting that you have reviewed the application and understand its contents.

The enclosed invention patent documents are as follows:

1. DECLARATION: Sign and fill in information
2. ASSIGNMENT: Sign and date

Also enclosed, is a stamped, self-addressed return envelope for your convenience to return the completed and signed documents to me at your earliest convenience.

If you have any questions please call me (949) 583-3515. Thank you for your cooperation in this matter.

Sincerely,



David J. Harshman, Esq.  
Assistant General Counsel

DJH:lj

Enclosures

cc: Charanjit Brahma

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**U.S. Postal Service**  
**CERTIFIED MAIL RECEIPT**  
*(Domestic Mail Only: No Insurance Coverage Provided)*

Article Sent To:	
7008	
8302	Postage \$
0008	Certified Fee
0008	Return Receipt Fee (Endorsement Fee)
0008	Restriction (Endorsement Fee)
0008	Total
3220	Tuan Nguyen 26575 White Oaks Drive Laguna Hills, California 92653
3220	Name (Printed by Mailed)
3220	Street, Apt. No.
3220	City, State, ZIP+4
PS Form 3800, July 1999      See Reverse for Instructions	

**SENDER: COMPLETE THIS SECTION**

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailing or on the front if space permits.

1. Article Addressed to:

Tuan Nguyen  
26575 White Oaks Drive  
Laguna Hills, California 92653

**COMPLETE THIS SECTION ON DELIVERY**

A. Received by (Please Print Clearly)	B. Date of Delivery
---------------------------------------	---------------------

C. Signature

Agent  
 Addressee  
 Yes  
 No

D. Is delivery address different from item 1?

If YES, enter delivery address below:

3. Service Type

<input checked="" type="checkbox"/> Certified Mail	<input type="checkbox"/> Express Mail
<input type="checkbox"/> Registered	<input checked="" type="checkbox"/> Return Receipt for Merchandise
<input type="checkbox"/> Insured Mail	<input type="checkbox"/> C.O.D.

4. Restricted Delivery? (Extra Fee)  Yes

2. Article Number (Copy from service label)

7099 3220 0008 8302 7008

PS Form 3811, July 1999

Domestic Return Receipt

102595-99-M-1789

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